

REMARKS/ARGUMENTS

Applicant would like to thank the Examiner for the careful consideration given the present application, and for the personal interview conducted on February 28, 2005. The application has been carefully reviewed in light of the Office action and interview.

Applicants note that no claim amendments are filed at this time, but that amendments based on the results of the personal interview are being considered and may be filed in the near future.

Claims 1-36 remain in this application.

The Examiner objected to the abstract. A replacement abstract is attached hereto, making the objection moot.

The Examiner provisionally rejected claims 1-36 under the judicially created doctrine of obviousness-type double patenting with respect to application 09/467,231, in view of Mauldin *et al.* (U.S. 5,664,227). The Examiner states that the claims are not patentably distinct.

Applicant traverses this rejection. The Examiner has admitted that the claims are different, but has not provided the proper motivation for modifying the claims of the '231 reference with the Mauldin teachings. Applicant notes that hindsight motivation is not proper, and that the Examiner has clearly obtained the motivation from the application itself. Thus, the rejection is improper, and should be withdrawn. Furthermore, the claims have been amended to further define the terminology in a manner that is clearly not taught by Mauldin. Finally, because neither application has matured into a patent, the rejection must be held into abeyance until one of the applications does so mature (and, of course, the rejection could not apply to the first application to mature into a patent).

Claims 1, 3-9, 11-17, 19-27, and 29-36 were rejected under 35 U.S.C. §103(a) as being

unpatentable over Mauldin *et al.* (U.S. 5,664,227). Claims 2, 10, 18, and 22 were rejected as above in further view of Ozsoyoglu *et al.* ("Automating the Assembly of Presentation from Multimedia Databases"). For the following reasons, the rejections are respectfully traversed.

It was discussed at the personal interview with the Examiner and her supervisor that the claims recite the context description data being input into the device or method according to the claims. However, the Examiner argued that the term "input" is very broad in a computer context. Even if broadly construed, the term still has some meaning that is not taught by the reference.

The Examiner has admitted, in the Office action, that Mauldin does not teach "scores that are attribute information of the media content...", instead apparently arguing that the reference suggests that matches to keywords are ranked according to relevance (see col. 7, lines 66 to col. 8, line 15). However, it is clear by the reference that the ranking is done by an internally performed weighing process (see col. 7, line 66 to col. 8, line 7), whereas the independent claims specifically recite that the scores are included in the content description data, which is *input* into the claimed device, not *internally* calculated as taught by Mauldin. Because the scores are input into the apparatus, they must be coming from *outside* of the apparatus. In contrast, Mauldin teaches that the apparatus itself calculates the weighing factors without any suggestion that the data be obtained elsewhere, and thus does not teach an input means for inputting the context description data including the scores. Thus, the independent claims are patentable over the reference.

Furthermore, regarding claims 2, 10, 18, and 28, the Examiner argues that Ozsoyoglu teaches hierarchically described data by teaching that segments are denoted by nodes (page 595, left column and Figs. 3.1 and 3.2). However, even if true, the reference does not teach the context description data as claimed (e.g., there are no "scores"), and thus does not overcome the

shortcomings of the Mauldin reference.

Accordingly, the prior art does not teach all of the claim limitations of the independent claims, and thus also the dependent claims, and thus they are patentable over the references.


Finally, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish prima facie obviousness (Id.). The prior art must also suggest the desirability of the combination (Id.). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (Id.).

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32161US2.

Respectfully submitted,

PEARNE & GORDON LLP

By:


Robert F. Bodi, Reg. No. 48540

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

Date: December 21, 2005